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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,966	01/18/2002	Mu-III Lim	CP-1230 (G-271ML)	3345

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THE PROCTER & GAMBLE COMPANY
Global Legal Department - IP
Sycamore Building - 4th Floor
299 East Sixth Street
CINCINNATI, OH 45202

EXAMINER

CHANNAVAJJALA, LAKSHMI SARADA

ART UNIT	PAPER NUMBER
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1611

MAIL DATE	DELIVERY MODE
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01/21/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/052,966	Applicant(s) LIM ET AL.	
	Examiner Lakshmi S. Channavajjala	Art Unit 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt of amendment, response and declaration all dated 10-21-08 is acknowledged.

Claims 1-3, 25 and 26 are pending. Claim 26 has been withdrawn as being non-elected.

Claims 1-3 and 25 are under consideration.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10-21-08 has been entered.

Rejection of claim 7-9 under 35 USC 103(a) as being unpatentable over DE 4200534 to Konrad or DE 4429344 to Rose et al in view of US 3951970 to Razdan. The above rejection has been withdrawn in light of the amendment.

2. The following rejection has been maintained:

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 4429344 (only abstract) to Rose et al.

Rose et al teach aminomethylated dihydroxybenzene compounds and their use in oxidative hair dyeing. The abstract specifically mentions the compound 4-[[bis(2-hydroxyethyl) aminomethyl]-1, 3-benzenediol.

While the compound of Rose is also a 1,3-benzene diol that is similar to the claimed compound, instant compound requires the aminomethyl substitution at the 2nd position as opposed to the 4-position of the compounds of Rose. However, the instant claimed compounds are obvious over the compound of Rose because both the compounds are structurally similar and hence expected to possess similar properties. In re Dillon, 919 F.2d at 692-93, 16 USPQ2d at 1900-02; In re Wilder, 563 F.2d 457, 460, 195 USPQ 426, 429 (CCPA 1977) (adjacent homologs and structural isomers).

5. Claims 1-3 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 4200534 (only abstract) to Konrad et al.

Konrad teaches 4-[[[(4-hydroxyphenyl) amino] methyl]-1, 3-benzenediol, as intermediate for developers for oxidative hair dyes to treat hair.

While the compound of Konrad is a 1,3-benzene diol compound that are similar to the claimed compounds, instant claimed compound requires the aminomethyl substitution at the 2nd position as opposed to the 4-position of the compounds of Rose and Konrad. However, the instant claimed compounds are obvious over the compound of Rose because both the compounds are structurally similar and hence expected to possess similar properties. In re Dillon, 919 F.2d at 692-93, 16 USPQ2d at 1900-02; In re Wilder, 563 F.2d 457, 460, 195 USPQ 426, 429 (CCPA 1977) (adjacent homologs

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and structural isomers). Further, the compounds of Konrad contain hydroxyphenyl as opposed to the phenyl group of claims 2 and 3. However, if the claimed invention and the structurally similar prior art species share any useful property, in this case, intermediates for oxidative hair dyeing, one of an ordinary skill in the art at the time of the instant invention would have been motivated to make the claimed species of compounds with an expectation to obtain compounds with similar properties based on structural similarities. Dillon, 919 F.2d at 693, 696, 16 USPQ2d at 1901, 1904.

Response to Arguments

Applicant's arguments and the declaration filed 10-21-08 have been fully considered but they are not persuasive.

Rejection of claims 1 and 25 under 35 USC 103(a) as being unpatentable over DE 4429344 to Rose et al:

Applicants argue that the claimed 2-aminomethyl substituted compounds are dye couplers and in contrast the compounds of Rose can undergo coupling only 6 position because of the unsubstituted 2-position is too sterically hindered by hydroxyl groups to undergo coupling. For this reason applicants argue that the two compounds would not be expected to possess similar properties, contrary to the assertions of the office. It is argued that consequently the hair coloring composition of Rose gives a different color than a composition containing instant compounds. Applicants' arguments are not persuasive because the rejection stated that structurally similar compounds are expected to render similar properties but not same properties. Accordingly, the argued

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differences in the ability to couple and also the ability to color the hair, though not present in the claims would have been expected by one of an ordinary skill in the art. Further, the compounds of Rose et al possess good hair coloring properties, which is in contrast to the arguments presented by applicants.

Rejection of claims 1-3 and 25 under 35 USC 103(a) as being unpatentable over DE 4200534 to Konrad et al.

Applicants argue that for the reasons mentioned in response to the above rejection over Rose et al, instant compounds and that of Konrad are not expected to possess similar properties. However, as explained above, structurally similar compounds are expected to render similar properties but not same properties. Therefore the argued differences that the structurally similar compounds possess similar properties (not the same extent or intensity of hair coloring) would have been expected by one of an ordinary skill in the art. Moreover, instant claims do not recite the argued limitations and the claims are directed to only a compound not a composition or a method. Further, the compounds of Konrad et al possess good hair coloring properties, which is in contrast to the arguments presented by applicants.

The Declaration of Dr. Lim under 37 CFR 1.132 filed 10-21-08 is insufficient to overcome the rejection of claims 1-3 and 25 based upon the teachings of Rose or Konrad under 35 USC 103(a) above and also as set forth in the last Office action. The declaration states that both the Rose compound and the Konrad compound are

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substituted with an aminomethyl group at the 4-position, which can therefore undergo coupling only at the 6-position (the unsubstituted 2-position is too sterically hindered by hydroxyl groups to undergo coupling). It is stated that the claimed compounds, in contrast, are substituted with an aminomethyl group at the 2-position, rendering the 4-position and the 6-position available for coupling, allowing for additional coupling reactions (reactions at the 4-position as well as the 6-position), and allowing for the formation of additional chromophores, thereby affecting the ultimate color imparted to the hair. It is further stated that when the compound of Rose or Konrad reacts with a primary intermediate dye precursor, such as p-phenylenediamine (or a derivative thereof), the chromophore generated is different from the chromophore generated from the reaction of the claimed compound with p-phenylenediamine. The declaration states that each of the above chromophores would impart a different color to hair due to the differing position of the -NR₁R₂ group, specifically, when the -NR₁R₂ group is ortho to the hydroxyl group, the two groups participate in hydrogen bonding, which affects the color of the chromophore and stabilizes the chromophore. Each of the chromophores would thus impart a different color to hair. Therefore the declaration concludes that the compounds of Konrad and Rose would not be expected to possess properties similar to the claimed compound, contrary to the assertions of the Examiner.

The declaration as well as the arguments are not found persuasive because the argument that the two chromophores generated (based on the compounds of prior art and instant compounds) would result in a different color is not based on a side by side comparison. Second, the rejection above stated that the compounds would be expected

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to have similar and not same properties. It is clear from applicants' own admission and also the disclosure of the references that the resulting compounds of the prior art would possess some utility i.e., hair coloring properties. Additionally, applicants have not provided any comparative data with respect to the hair coloring caused by the prior art compounds which arguably have a steric hindrance by hydroxy groups to undergo coupling due to the unsubstituted 2-position. The argument that the color imparted by the chromophores generated by the prior art compounds is different from the chromophores generated by instant compounds is not persuasive because the term "different" is relative. Applicants merely argue regarding the steric hindrance caused by the 2-position of NR1R2 without actually showing any evidence.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 9.00 AM -5.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila G. Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lakshmi S Channavajjala/
Primary Examiner, Art Unit 1611
January 15, 2009